

REMARKS

Claims 41-43, 45-53, 55-64, and 74-81 are pending. In this response, claims 41, 43, 47-52, 55, 58-61, 63, 64, 74 and 75 are amended, claims 76-81 are new, and claims 44, 54, and 65-73 are cancelled. Applicant reserves the right to file continuing applications directed to the cancelled claims, as well as the subject matter disclosed but not claimed in the present application, including the claims as set forth in the preliminary amendment filed April 21, 2004 and May 11, 2004.

Independent claims 41, 43, 52, 61, 74, and 75 have been amended to generally recite the feature of "satellite audio radio." Support for the amendment can be found in the cancelled claims, in the as filed specification at paragraph 71 as well as in prophetic examples 3, 4, and 5. Support for independent claim 76 can also be found in the specification and prophetic examples.

Claim Rejections Under 35 U.S.C. § 102(e) Are Moot

Claims 41-43, 45, 52-53, 61-64, 66-69 and 71-75 were rejected under 35 U.S.C. § 102(e) as allegedly anticipated by Robbins, U.S. Patent No. 6,317,882, for the reasons set forth on page 2 of the Office Action.

A claim is anticipated under 35 U.S.C. § 102 only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). As detailed above, the applicant has amended the independent claims to recite the feature of "satellite audio radio." The Examiner correctly noted on page 7 of the Office Action, Robbins does not teach or suggest using satellite audio radio in the present invention. Further claims 66-69 and 71-73 have been cancelled.

Thus, the reference cited does not disclose each and every element recited in the pending claims, and does not anticipate them. Reconsideration and withdrawal of the rejection is respectfully requested.

Claim Rejections Under 35 U.S.C. § 103 Should Be Withdrawn

Claims 44, 47-48, 50-51, 54-56, 58, 65 and 70 stand rejected under 35 U.S.C. § 103 as unpatentable over Robbins in view of Wugofski, U.S. Patent No. 6,507,951, for the reasons set forth on page 7 of the Office Action. Claim 57 stands rejected under 35 U.S.C. § 103 as unpatentable over Robbins in view of Wugofski, in further view of Barton et al., U.S. Patent No. 6,233,389, for the reasons set forth on page 9 of the Office Action. Claims 49 and 59 stand rejected under 35 U.S.C. § 103 as unpatentable over Robbins in view of Wugofski, in further view of Wall, U.S. Patent No. 6,055,244, for the reasons set forth on page 9 of the Office Action.

As described above, pending independent claims 41, 43, 52, 61, 74 and 75 have been amended to generally recite the feature of "satellite audio radio," a feature originally recited in dependent claims 44, 54, 65, and 70. New claim 76 also recites this feature. Accordingly applicant submits that the rejection of the claims under §103 over Robbins in view of Wugofski is improper and should be withdrawn for the following reasons.

Applicant submits that when the art is properly considered as a whole, one of skill in the art would not have been motivated to combine the references in the manner suggested, and that even if combined the combination of references does not teach or disclose the claimed invention.

First, the Examiner is correct in asserting that Robbins does not teach satellite audio radio, as indicated in the Office Action at page 7. Furthermore, according to the Patent Office (the Office), Wugofski discloses a time shifting system that combines many forms of media communication including audio/video satellite broadcasts and thus the combination renders the claimed invention obvious. However, the general feature recited in Wugofski, which is used as a basis for the combination, *already exists* in Robbins. Specifically, Robbins discloses receiving satellite television at column 45, line 59, through column 46, line 5. Accordingly, and contrary to the assertion of the Office, one of skill in the art *would not* be motivated to combine Robbins with Wugofski because Robbins already recites receiving a broadcast from a satellite and because it is redundant

to combine Robbins with Wugofski for the purpose of providing the feature of satellite broadcasts.

Second, when considered as a whole, neither reference provides the requisite motivation to combine Wugofski and Robbins. Wugofski describes a system for selecting channels in a multi-channel convergence system. Wugofski also provides a channel map which includes a listing of receivers of programming associated with the convergence environment and a listing of channels associated with the receivers, as generally described at column 3 and again at column 5, lines 20 to 52 of Wugofski, and resolving conflicts that arise between receivers which are communicatively coupled to the system, as generally described at column 8 of Wugofski. Robbins is directed to reminding a user of a receiver that a broadcast is on a data stream. Robbins' methods concern separate receiver types (e.g., television or radio or internet related embodiments, etc.), as described at column 10, line 40 through column 11, line 9, and not to resolving conflicts *between* receiver types.

One of skill in the art *would not* be motivated to combine Wugofski with Robbins to allow many types of audio/video network communications to converge into one system, as suggested by the Office, because Robbins is directed to methods which concern different types of network communication devices and not integration of communication devices. Thus, with respect to Robbins, no need exists to reduce the number of connections that a user has to keep track of. Therefore the motivation to combine the two references as suggested by the Office does not exist.

In fact, the reasoning offered to combine Wugofski with Robbins would merely result in an increase in the number of types of devices detected by the invention of Robbins and resolving any conflicts between the devices. The proposed reasoning is irrelevant to the presently claimed invention because the presently claimed invention is directed to a single media type device which detects satellite audio radio.

As the Examiner is aware, the requirement, in 35 U.S.C. § 103(a), "at the time the invention was made" is to avoid impermissible hindsight. MPEP § 2141.01. Thus, an Examiner "must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and

just before it was made.” MPEP § 2142. This is important, as “impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.” *Id.* Consequently, when determining whether or not a claimed invention is obvious, one must cast his “mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field.” *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999).

Based on the above principles, Applicant respectfully submits that the Examiner’s rejection of the claims in view of the references is based on the use of impermissible hindsight, wherein the claimed invention is used as a blueprint for the selection and combination of prior art. This is particularly clear when one considers that the references fail to disclose or suggest every element of the presently claimed invention- namely none recite the claimed feature of “satellite audio radio.” More specifically, even if combined in the manner suggest by the Office, the references do not provide each and every feature of the claimed invention, as detailed hereafter.

On page 7 of the Office Action, the Examiner correctly notes that Robbins does not explicitly teach a satellite audio radio network. The Examiner then points to Wugofski at column 4, lines 39 to 49, for many types of media communication, including audio/video satellite broadcasts. The relevant cited portion of Wugofski reads as follows:

“Computer 110 desirably provides for integration with or includes audio/video (i.e., multimedia) devices, including but not limited to, a sound card, a digital video disc (DVD) player, a direct broadcast satellite (DBS) receiver, a TV tuner (for broadcast and/or cable TV), audio/video inputs for external or auxiliary devices, a CD-ROM player, an audio/video tuner having at least radio tuning capability, a cable decoder, a videocassette recorder, a laser disc player, a compact disc player, a DBS integrated receiver-decoder (IRD), and a video camera.”

Wugofski does not suggest, much less disclose or teach the feature of “satellite audio radio.” The only mention of a satellite related apparatus or method in the

cited paragraph is in reference to a direct broadcast satellite (DBS) *receiver*, which falls far short of the necessary disclosure for a *prima facie* showing of obviousness of the pending claims which require satellite audio radio. In fact, in the context of Wugofski, the satellite signals received by the DBS receiver appear to be satellite *television* broadcasts. Specifically, the term "satellite" is used about ten times in Wugofski, twice in the background, and eight times in the detailed description. A fair reading of Wugofski indicates the term is used in reference to satellite television, e.g., DSS and Echostar, as detailed at column 5, line 37, and "set-top" boxes at column 7, line 13. As noted above, these are the same general type of broadcasts referred to in Robbins, and Robbins has already been established as being devoid of any mention of "satellite audio radio." In no instance does Wugofski refer to or suggest "satellite audio radio," either.

Neither Barton et al. nor Wall cure the deficiencies of Robbins and Wugofski with respect to the amended claims and any of the claims which depend therefrom. Specifically, both Barton et al. and Wall fail to suggest, much less disclose, the claimed limitation of "satellite audio radio," much less propose such a combination with Robbins.

Similarly, new claim 76 also recites "satellite audio radio" and is allowable for all the reasons set forth above. New claims 77 through 80 depend upon claim 76 and are also allowable by virtue of the dependency upon claim 76.

In sum, applicant respectfully submits that the Patent Office has not established a *prima facie* case of obviousness. Because 1) Wugofski does not render any of the pending claims obvious, 2) none of the cited references recite the feature of "satellite audio radio," and 3) because neither Barton et al. nor Wall cure the deficiencies of Wugofski and/or Robbins, applicant respectfully requests that all of the rejections of the claims under §103 should be re-considered and withdrawn.

Conclusion

Applicant respectfully submits that all claim rejections have been overcome and that all pending claims are now in condition for allowance, early notice of which is earnestly solicited.

Respectfully Submitted,

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